

REMARKS**I. Introduction**

Claims 1-24, 27-30, 33, and 35 are currently pending in the present application.

Claims 1, 30, 33, and 35 are independent. All claims stand rejected. In particular,

(A) claims 12 and 13 stand rejected under 35 U.S.C. §112, second paragraph, for being indefinite,

(B) claims 1-2, 5, 8, 14-18, 22, 24, 27, 30, and 35 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 5,926,796 (hereinafter "Walker"),

(C) claims 16-18, 20, 23, 28, and 29 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Walker,

(D) claims 1-2, 5-10, 12, 14-15, 22, 24, and 30 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Patent No. 6,138,911 (hereinafter "Fredregill"),

(E) claims 3, 4, 13, 16-17, 19-20, 23, and 28 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill,

(F) claim 21 stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill in view of www.atpos.com (herinafter "@POS"), and

(G) claim 33 stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill in view of U.S. Patent No. 5,893,075 (hereinafter "Plainfield").

Upon entry of this amendment, which is respectfully requested, dependent claim 2 will be cancelled without prejudice or disclaimer and independent claims 1, 30, and 33 and dependent claims 9-13 will be amended. No new matter is introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. Priority Claim

In accordance with 37 C.F.R. § 1.78(a), the Specification is amended herein to indicate a claim to the benefit of priority of U.S. Patent Application No. 09/335,644, filed June 18, 1999, which issued on November 13, 2001, as U.S. Patent No. 6,317,723 B1, which is a continuation of U.S. Patent Application Serial No. 08/841,791, filed May 5, 1997, which issued on July 20, 1999, as U.S. Patent No. 5,926,796 B1 (Walker). The present application (filed June 30, 2000) and the prior-filed 09/335,644 application were co-pending.

In accordance with 37 C.F.R. § 1.78(a)(1), the prior-filed application 09/335,644 names as an inventor at least one inventor (*e.g.*, Jay Walker) named in the present (later-filed non-provisional) application, and also discloses the named inventor's invention claimed in at least one claim of the present (later-filed non-provisional) application in the manner provided by the first paragraph of 35 U.S.C. §112.

The present (later-filed) application is pending. As the present application was filed under 35 U.S.C. 111(a) before November 29, 2000, Applicants may submit the reference to claim priority at this time without a petition. See, 37 C.F.R. § 1.78(a)(2)(ii)(B).

This priority claim is made solely in order to expedite prosecution.

III. The Examiner's Rejections

All pending claims stand rejected. Applicants respectfully traverse all grounds for rejection, to be addressed separately, as follows.

A. Rejections Under §112, second paragraph

Claims 12 and 13 stand rejected under 35 U.S.C. §112, second paragraph, for being indefinite. Applicants amend claims 12 and 13 herein to clarify that the "attendant" being referred to is indeed "the" attendant for which an antecedent basis exists. Applicants accordingly respectfully request that the §112, second paragraph rejections of claims 12 and 13 be withdrawn.

B. Rejections Under §102(e) – Walker

Claims 1-2, 5, 8, 14-18, 22, 24, 27, 30, and 35 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Walker. This ground for rejection is moot, however, at least in light of the amendment herein that perfects the priority claim to Walker via U.S. Application No. 09/335,644, making Walker unavailable as prior art under §102(e). See, MPEP § 706.02(b) “Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent [R-1].” Applicants therefore respectfully request that this §102(e) ground for rejection of claims 1-2, 5, 8, 14-18, 22, 24, 27, 30, and 35 be withdrawn.

C. Rejections Under §103(a) – Walker

Claims 16-18, 20, 23, 28, and 29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker. This ground for rejection is moot, however, at least because Walker is no longer an appropriate reference under §102(e), as described in B, above. Applicants therefore respectfully request that this §103(a) ground for rejection of claims 16-18, 20, 23, 28, and 29 be withdrawn.

D. Rejections Under §102(e) – Fredregill

Claims 1-2, 5-10, 12, 14-15, 22, 24, and 30 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by Fredregill. Applicants traverse this ground for rejection as follows.

I. The reference fails to teach or suggest: *analyzing the verbal response*

Applicants respectfully assert that Fredregill fails to teach or suggest limitations of independent claim 1. In particular, Fredregill fails to teach or suggest *analyzing, by the processing device, the verbal response*.

With respect to the limitation of *analyzing, by the processing device, the verbal response* (a limitation generally incorporated from now cancelled claim 2), the Examiner fails to address, in any manner whatsoever, how it is believed that such a limitation is anticipated by Fredregill. In light of the Examiner's failure to address this limitation, Applicants have reviewed the entirety of Fredregill in an attempt to locate the teachings relied upon by the Examiner. There is, however, no teaching or suggestion anywhere in Fredregill that is related to a processing device analyzing a verbal response received from a customer. Fredregill does not even, for example, contemplate the receipt or recording of such a verbal response, much less any analysis thereof. Indeed nowhere does Fredregill describe any technology capable of effectuating such limitations (such as voice recognition software, a microphone, and/or video or audio capture or recording devices). See, Present Application, Specification, pg. 6, lines 6-11; FIG. 1, customer input/output device 114, 124; pg. 20, lines 5-10; pg. 27, lines 1-10.

Accordingly, at least because Fredregill fails to teach or suggest *analyzing, by the processing device, the verbal response*, Fredregill fails to anticipate independent claim 1. Applicants therefore respectfully request that this § 102(e) rejection of independent claim 1 be withdrawn.

2. The reference fails to teach or suggest: *prompting, in the case that the at least one query is determined to satisfy the timing condition, an attendant to present the at least first query*

Applicants respectfully assert that Fredregill fails to teach or suggest limitations of independent claim 30. In particular, Fredregill fails to teach or suggest *prompting, in the case that the at least one query is determined to satisfy the timing condition, an attendant to present the at least first query*.

Fredregill simply does not contemplate the utilization of any sort of conditions to limit or govern when a query should be presented to a customer. Nowhere does Fredregill describe only asking the customer if points should be redeemed based on any sort of timing consideration. Fredregill does not, for example, contemplate only presenting such a question to the customer (i) during certain times of the day or week, (ii) based on

current or expected service times, or (iii) based on times of high customer traffic or high sales. See, Present Application, Specification, pg. 14, lines 12-21.

Accordingly, at least because Fredregill fails to teach or suggest *prompting, in the case that the at least one query is determined to satisfy the timing condition, an attendant to present the at least first query*, Fredregill fails to anticipate independent claim 30. Applicants therefore respectfully request that this §102(e) rejection of independent claim 30 be withdrawn.

3. Dependent Claims

Dependent claims 2, 5-10, 12, 14-15, 22, and 24 are believed patentable at least for depending upon a patentable base claim (*i.e.*, independent claim 1). Applicants therefore respectfully request that the §102(e) rejections of dependent claims 2, 5-10, 12, 14-15, 22, and 24 be withdrawn.

Further, many dependent claims recite limitations not taught or suggested by Fredregill. Fredregill does not, for example, teach or suggest *determining an offer, the offer determined based at least in part on the verbal response* (claim 24). The Examiner has simply failed to address this limitation, and nowhere is such a limitation taught or suggested by Fredregill. Fredregill does not, for example, contemplate determining any sort of offer based on the customer's verbal response. The option to redeem points described in Fredregill, for example, is determined based on transaction criteria, not on a verbal response of the customer. Applicants accordingly respectfully request that this §102(e) rejection of dependent claim 24 be withdrawn.

E. Rejections Under §103(a) – Fredregill

Claims 3, 4, 13, 16-17, 19-20, 23, and 28 stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill. A reading of these rejections reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not even disclosed or suggested by any evidence of record. Accordingly, the Examiner has not presented a *prima facie* case of obviousness of any of claims 3, 4, 13, 16-17, 19-20, 23, and 28.

1. The Proper Legal Standard under 35 U.S.C. § 103(a)

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. *In re Rouffet*. The secondary considerations are also essential components of the obviousness determination. *In re Rouffet*.

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the *prima facie* burden only by showing some objective teaching leading to the purported combination of references. *In re Fritch*. Lacking a motivation to combine references, there is no *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. *Cardiac Pacemakers v. St. Jude*

Medical 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would prima facie have been obvious. Id. The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 60 U.S.P.Q.2D 1001, 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 54 U.S.P.Q.2D 1664, 211 F.3d 1367 (Fed. Cir. 2000). The “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” In re Morris, 44 U.S.P.Q.2D 1023, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

2. Substantial evidence is required of all factual findings

In a determination of obviousness, factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be supported by substantial evidence. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

"[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Moreover, where a conclusion of obviousness rests on the prior knowledge in the field of the invention, then that "[p]rior knowledge in the field of the invention must be supported by tangible teachings of reference materials." *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371 (Fed. Cir. 2004).

3. *Absent substantial evidence, no prima facie case exists*

To reject claims in an application under Section 103, an examiner must show an un rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

The initial burden of presenting a *prima facie* case of obviousness is upon the examiner. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 U.S.P.Q.2D 1955, 9 F.3d 1531, 1532 (Fed. Cir. 1993); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

4. *§103(a) Rejections of claims 3, 4, 13, 16-17, 19-20, 23, and 28*

The Section 103 rejections of claims 3, 4, 13, 16-17, 19-20, 23, and 28 are flawed at least because the Examiner has not made a *prima facie* case of obviousness:

- the Examiner has failed to provide substantial evidence for a motivation to modify the reference in the manner suggested; and
- The reference, either alone or in combination with other references of record, fails at least to teach the claim limitation of *analyzing, by the processing device, the verbal response*.

In other words, claims 3, 4, 13, 16-17, 19-20, 23, and 28 recite **utilizing a processing device to analyze a customer's voice response**. (as incorporated from independent claim 1, upon which each of claims 3, 4, 13, 16-17, 19-20, 23, and 28 ultimately depends).

a) No Prima Facie Showing of Obviousness

A reading of the rejections of claims 3, 4, 13, 16-17, 19-20, 23, and 28 reveals that the Examiner's attempt to provide a motivation to modify the reference as suggested falls far short of meeting the requirements for establishing a *prima facie* case or obviousness. Further, the Examiner's reliance upon bold assertions of what is allegedly "old and well known" to make up for the deficiencies of the reference fails to satisfy the burden for a *prima facie* case of obviousness. The Examiner has not, for example, supplied any evidence on the record (much less the necessary substantial evidence) to support the Examiner's assertions (ignoring a request to do so at the behest of Applicants). Accordingly, the Examiner has not presented a *prima facie* case of obviousness of claims 3, 4, 13, 16-17, 19-20, 23, and 28.

b) No Showing that Claim Limitations Are in the Reference

The Examiner has rejected claims 3, 4, 13, 16-17, 19-20, 23, and 28 as unpatentable over Fredregill. However, the Examiner has not provided any explanation as to what teaching or suggestion in this reference, either alone or in combination with any other reference, teaches or suggests the following limitation of claims 3, 4, 13, 16-17, 19-20, 23, and 28:

analyzing, by the processing device, the verbal response.

As described in D.1. above, Applicants have carefully reviewed the reference and have failed to find any teaching or suggestion that would even remotely suggest the above-quoted limitation of claims 3, 4, 13, 16-17, 19-20, 23, and 28.

c) Official Notice

Further, the Examiner's rejections of claims **3, 4, 13, 16-17, 19-20, 23, and 28** are based not solely upon teachings alleged to be within Fredregill, but are also based in part on unsupported general assertions of what was "old and well known" before the time of Applicants' invention. Office Action mailed May 19, 2005, pgs. 5-6. Applicants respectfully traverse the Examiner's Official Notice of these recited features alleged to make up for the deficiencies of Fredregill.

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statements, Applicants cannot properly determine the bounds of the prior art relied upon by the Examiner. Accordingly, Applicants once again dispute that the subject matter asserted was "old and well known" at the time the invention was made, and request, for each of claims **3, 4, 13, 16-17, 19-20, 23, and 28**, a reference to clarify the subject matter in more detail. MPEP §2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noted subject matter cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference teaching**." (emphasis added)).

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); *In re Eynde*, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**") (emphasis added); *In re Pardo*, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

d) No Motivation to Combine Provided

Regarding motivation to combine, as discussed above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The motivation provided by the Examiner for modifying Fredregill is described only by general assertions of potential benefits that may be realized by practicing the claimed embodiments.

These motivations fail for various reasons. Asserting that it would be obvious to modify a reference to include a feature of another reference to provide a benefit, for example, leaves unanswered the question of *why* one of ordinary skill in the art would have been motivated to make the modification, absent a reading of Applicants' disclosure.

As discussed above with respect to the applicable law, it is the burden of an examiner to provide in the record relevant findings of fact adequate to show *why* one of ordinary skill in the art would have been motivated to modify a reference in a manner proposed by the examiner. This Examiner, however, has not indicated any reasoning for (much less any evidence of) either (1) *why* one of ordinary skill in the art would have looked to Official Notice based on the teachings of Fredregill, or *vice versa*; or (2) if there is substantial evidence that Official Notice is somehow relevant to Fredregill (which Applicants dispute), why, of all the subject matter discussed in Official Notice, one of ordinary skill in the art would have selected the specific teachings identified by the Examiner to modify the Fredregill system.

For example, the Examiner may provide support for the proposed modification by providing substantial evidence about knowledge of one of ordinary skill in the art or by pointing to a statement in the reference that would have prompted the proposed modification. Nor does the Examiner provide any evidentiary support for the Official Notice relied upon to allegedly make up for the deficiencies of Fredregill.

No such findings of fact have been made in support of the rejection of claims 3, 4, 13, 16-17, 19-20, 23, and 28. The Examiner's assertions are completely devoid of any reasoning or fact finding as to *why* one of ordinary skill in the art would have been motivated to make the proposed modifications to Fredregill. The Board is not permitted to accept conclusory findings made by the Examiner that are not supported by any evidence of record. *In re Zurko*, 59 U.S.P.Q.2D 1693, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 61 U.S.P.Q.2D 1430, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Thus, in summary, the Examiner has not shown a motivation supported by evidence in the record to modify the reference of record in any manner that renders any of claims 3, 4, 13, 16-17, 19-20, 23, and 28 obvious.

e) No Showing of Level of Ordinary Skill in the Art

Moreover, the Examiner has also failed to resolve (or even identify) the level of ordinary skill in the pertinent art as required by the Supreme Court. Graham v. John Deere Co., 383 U.S. 1, 17 (1966). Having failed to resolve the level of ordinary skill in the art in the record, Applicants asseverate that the Examiner is unable to determine either what would have been “old or well known” or what references would have been analogous.

In summary, the Examiner has not established a *prima facie* case of obviousness with respect to claims 3, 4, 13, 16-17, 19-20, 23, and 28 at least because the Examiner has not shown that all claim limitations are taught or suggest by the prior art nor shown a motivation in the prior art of record to modify the reference in any manner that renders claims 3, 4, 13, 16-17, 19-20, 23, and 28 obvious. Thus, the Section 103(a) rejections of claims 3, 4, 13, 16-17, 19-20, 23, and 28 should be reversed.

F. Rejections Under §103(a) – Fredregill in view of @POS

Claim 21 stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill in view of @POS. Applicants traverse this ground for rejection as follows.

Applicants hereby reiterate the reasons presented at D and E above that describe the inadequacies of both the §102(e) and the §103(a) grounds for rejection based on Fredregill. As such, Applicants believe that claim 21 is patentable at least for depending upon a patentable base claim (claim 1).

Applicants also submit that @POS simply fails to make up for the deficiencies of Fredregill. @POS does not, for example, teach or suggest **analyzing a customer’s voice response via a processing device**.

Applicants further submit that the Examiner has failed to provide evidence of any viable motivation or suggestion to combination @POS with Fredregill. The Examiner simply provides the conclusory statement that “it would have been obvious to one of

ordinary skill in the art to modify the method of [Fredregill]...to provide portability so that the POS could be set up where needed.” Office Action mailed May 19, 2005, pg. 8, third paragraph. This conclusory statement, without more, is not sufficient to overcome the Examiner’s burden of proving a *prima facie* case of obviousness.

Further, Applicants note that the earliest download date of the web page material defining the @POS reference is October 26, 1999, while the effective filing date of the present application is at least June 18, 1999 (pursuant to the priority claim presented herein) or August 17, 1998 (pursuant to the previously submitted priority claim). As such, it is not clear how the Examiner believes that the @POS reference may be utilized as prior art in rejecting claim 21.

At least for these reasons, Applicants request that the §103(a) rejection of claim 21 be withdrawn.

G. Rejections Under §103(a) – Fredregill in view of Plainfield

Claim 33 stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Fredregill in view of Plainfield. Applicants traverse this ground for rejection as follows.

Applicants hereby reiterate the reasons presented at D and E above that describe the inadequacies of both the §102(e) and the §103(a) grounds for rejection based on Fredregill. Applicants believe that claim 33 is patentable at least for these reasons.

Applicants also submit that Plainfield simply fails to make up for the deficiencies of Fredregill. Plainfield does not, for example, teach or suggest **analyzing a customer’s voice response via a processing device**.

Applicants further submit that the Examiner has failed to provide evidence of any viable motivation or suggestion to combination Plainfield with Fredregill. The Examiner simply provides the conclusory statement that “it would have been obvious to one of ordinary skill in the art to modify the method of [Fredregill]...in order to better serve the customer and to better focus marketing efforts.” Office Action mailed May 19, 2005, pg. 8, first paragraph. This conclusory statement, without more, is not sufficient to overcome the Examiner’s burden of proving a *prima facie* case of obviousness.

At least for these reasons, Applicants request that the §103(a) rejection of claim 33 be withdrawn.

IV. Subject Matter Without Support in the Record

Subject matter without support in the record is not substantial evidence and accordingly cannot support a *prima facie* case of obviousness.

In the Office Actions mailed on October 4, 2003 and April 21, 2004, the Examiner made various assertions as to what was “old and well known” in the art. In the Office Action mailed on May 19, 2005, the Examiner provides a list of nine (9) unsupported assertions as to what the Examiner regards as knowledge that was “old and well known”. The Examiner argues the unsupported assertions (i) were not “adequately” traversed by Applicants and (ii) as a result are now “admitted prior art,” based on the Examiner’s reading of MPEP §2144.03(c). Office Action mailed May 19, 2005, pg. 2, second heading.

Applicants have made several responses to this attempt by the Examiner to base a *prima facie* case of obviousness on unsupported assertions. The burden is not on Applicants to disprove any allegation unproven and unsupported by any evidence of record, so it is irrelevant whether such traverse is adequate or not. The burden is on the Examiner to build a *prima facie* case of obviousness on substantial evidence made of record. Also, Applicants submit that none of the Examiner’s unsupported assertions are “admitted prior art.”

a) No evidence has ever been provided in support of assertions that the Examiner alleges were not “adequately traversed”

Applicants note that the scope of the matter of which the Examiner (i) takes “official notice” or (ii) simply asserts is obvious, is limited to the substantial evidence in the record for such matter (as described elsewhere herein).

The references of record clearly do not support the Examiner’s broad assertions as to what was “obvious” or “well known.” The Examiner has not asserted otherwise.

Accordingly, the Examiner's assertions that are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application. Only the content of the references of record that are prior art to the present application may be so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

The burden is on the Examiner to establish a *prima facie* case based on substantial evidence. Where, as here, no evidence has been provided in support of what the Examiner insists is now "admitted prior art," no *prima facie* case has been established, and Applicants are under no obligation to rebut the Examiner's assertions with additional evidence or otherwise create "reasonable doubt" to overcome the rejections.

Any alleged failure of the Applicants to dispute what the Examiner has not proven could not suddenly transform any unsupported rejection into a *prima facie* case of obviousness. A *prima facie* case requires substantial evidence of record—the record still does not include any such evidence of the assertions the Examiner believes were not "adequately traversed."

Thus, there was and is no burden on Applicants to traverse assertions that no evidence of record could support, that the Examiner does not even allege are supported by the record, and which the Examiner has twice now been unwilling or unable to support with any evidence.

b) Applicants traverse the unsupported assertions

Applicants hereby traverse the Examiner's unsupported assertions listed throughout the current Office Action. Arguably, "reasonable doubt" as to the accuracy of the Examiner's understanding of what the Examiner insists was "well known" and "knowledge generally available" is already created where the Examiner subsequently is unable or unwilling to point to any evidence of such knowledge in the prior art. Such unsupported conclusory statements cannot possibly be considered "admitted" by Applicants, at least because the scope of such assertions, without supporting evidence, is entirely unclear. Further, Applicants have indeed traversed such assertions in previous

responses, as well as requested evidentiary support so that such assertions may be properly contemplated by Applicants. No such supporting evidence has yet been offered by the Examiner.

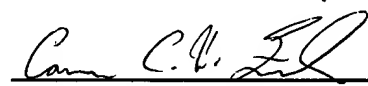
V. Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

Respectfully submitted,

August 19, 2005
Date



Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7300 /fax